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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/397,491	09/15/1999	STANISLAV KHIRMAN	NARSP003	8814

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT PAPER NUMBER

2155

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/397,491

Applicant(s)

KHIRMAN ET AL.

Examiner

George Neurauter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 29-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,8,9.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 29-32, 35-40, and 42 rejected under 35 U.S.C. 102(e) as being anticipated by Iwamura [US Patent #6,272,535].

Regarding claim 29, Iwamura discloses a method of controlling access from a device on a network including a plurality of interconnected devices, the method comprising:

monitoring a request signal from a first device for data on a second device in the network, the request signal including a user identification parameter [column 7, lines 45-62];

determining whether the access to the data requires a credit value [column 5, lines 15-20];

determining whether a user identified by the user identification parameter is permitted access to the data [column 5, lines 32-40];

detecting a pre-set credit parameter in the request signal [column 7, lines 45-55]; and
comparing the pre-set credit parameter with a pre-determined value to determine
permission to access the data [column 5, lines 35-40].

Regarding claim 30, Iwamura discloses a method of controlling access of claim 29,
further comprising providing access to the data in response to the user having permission to
access the data and the pre-set credit parameter being greater than or equal to a predetermined
value [column 5, lines 35-40].

Regarding claim 31, Iwamura discloses a method of controlling access of claim 29,
further comprising preventing access to the second device in response to the pre-set credit
parameter being less than or equal to a predetermined value [column 5, lines 32-40 and 55-57].

Regarding claim 32, Iwamura discloses the method of claim 29, further comprising
re-directing the data signal to a third device in response to the pre-set credit parameter being less
than a predetermined value, the third device allowing for a re-setting of the pre-set credit
parameter to a new pre-set credit value comprising a value greater than or equal to the
predetermined value [column 6, lines 20-30].

Regarding claim 35, Iwamura discloses the method of claim 29, further comprising
providing access to a second data that does not require a credit value in response to one of the
pre-set credit value being less than or equal to the pre-determined value or the user not having
permission to access the data corresponding to the request signal [column 20, lines 62-67].

Regarding claim 36, Iwamura discloses a network-based billing method for providing
access to resources on a network, the method comprising:

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monitoring a data signal from a device on a network, the data signal including a request for a resource, the resource including a value parameter [column 7, lines 45-62];
identifying a cost for accessing the resource [column 5, lines 18-20];
associating a user identification with the data signal [column 7, lines 45-62];
identifying a credit balance for the user identification [column 8, lines 8-13]; and
comparing the credit balance with the cost to determine access to the resource [column 5, lines 32-38].

Regarding claim 37, Iwamura discloses the network-based billing method of claim 36, further comprising allowing access to the resource in response to the credit balance being less than or equal to the cost preventing access to the resource [column 5, lines 18-20 and 32-38].

Regarding claim 38, Iwamura discloses the network-based billing method of claim 36, further comprising allowing access to the resource in response to the credit balance being greater than or equal to the cost preventing access to the resource [column 5, lines 18-20 and 32-38].

Regarding claim 39, Iwamura discloses the method of claim 36, further comprising re-directing the data signal to a second resource in response to the credit balance being less than the cost, the second resource configured to allow for increasing the credit balance [column 6, lines 20-30].

Regarding claim 40, Iwamura discloses the method of claim 36, further comprising providing access to a second resource having no cost in response to the credit balance being less than the cost [column 20, lines 62-67].

Regarding claim 42, Iwamura discloses the method of claim 36, further comprising passing the data signal to a second device having the resource [column 5, lines 12-18].

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 33-34 and 41 rejected under 35 U.S.C. 103(a) as being unpatentable over Iwamura [US Patent #6,272,535] in view of "Some FAQs about Usage-Based Pricing" (hereon referred to as "Pricing").

Regarding claim 33, Iwamura discloses the method of claim 29.

Iwamura discloses a method wherein the predetermined value is one from a group comprising a positive monetary value [column 7, lines 47-50] and a positive time value [column 22, lines 13-15].

Iwamura fails to disclose whether a bandwidth value, a quality of service value, or a content rating may be used as a predetermined value.

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"Pricing" discloses that a bandwidth value [page 5, "What are Smart Markets?"], a quality of service value [page 6, "What About Pricing Multiple Qualities of Service?"], and a content rating [page 6, "What Are Other Proposals?"] may be used as predetermined values.

It would have been obvious to one skilled in the art at the time the invention was made to use the predetermined values as described in "Pricing" along with the predetermined values and the method of claim 29 as described in Iwamura. "Pricing" discloses that the client is willing to pay money to access data [page 5, "What are Smart Markets?", lines 5-6] which is within the scope of the method of controlling access as described in Iwamura and would have been obvious to one skilled in the art.

Regarding claim 34, Iwamura discloses the method of claim 33.

Iwamura discloses a method further comprising allowing access to one from a group comprised of voice data, video data, and a real-time application in response to a value being greater than or equal to a threshold value [column 4, lines 1-6; column 5, lines 35-40].

Iwamura fails to disclose whether the value that is greater than or equal to a threshold value comprises at least one of bandwidth or quality of service values.

"Pricing" discloses the use of bandwidth values [page 5, "What are Smart Markets?"] and quality of service values [page 6, "What About Pricing Multiple Qualities of Service?"] in allowing access to data within networks.

It would have been obvious to one skilled in the art at the time the invention was made to use the bandwidth and quality of service values as described in "Pricing" along with the method as described in Iwamura. "Pricing" discloses the use of real-time applications, voice data, and video data being used on a network [page 9, "5. How Do We Keep Things The Way They

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Were?"]]. "Pricing" also discloses that networks have bandwidth and quality of service values to prioritize usage of a network in order to deliver access to those willing to pay the cost for accessing the network resources [page 1, "Why is usage-based pricing desirable?"]. The teachings of "Pricing" fall within the scope of the method as described in Iwamura and would have been obvious to one skilled in the art.

Regarding claim 41, claim 41 is also rejected under 35 USC 103(a) based upon the motivations for rejection regarding claim 33 since claim 41 embodies all of the limitations of claim 33.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following prior art teaches the state of the art in controlling information access within networks:

US Patent 6,141,754 to Choy;

US Patent 6,078,908 to Schmitz.

The following prior art teaches the state of the art in controlling information access within networks based upon monetary values:

"Economic FAQs About the Internet" by Jeffrey K. MacKie-Mason and Hal R.

Varian;

"Pricing the Internet" by Jeffrey K. MacKie-Mason and Hal R. Varian.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Neurauter whose telephone number is 703-305-4565. The examiner can normally be reached on Mon-Fri 8am-4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

gcn
May 17, 2002


DAVID WILEY
PRIMARY EXAMINER